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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,667	11/14/2005	Franz Xaver Gilg	60718-001	2329
27305	7590	06/24/2009		
HOWARD & HOWARD ATTORNEYS PLLC			EXAMINER	
450 West Fourth Street			LUK, EMMANUEL S	
Royal Oak, MI 48067			ART UNIT	PAPER NUMBER
			1791	
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			06/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,667	<b>Applicant(s)</b> GILG, FRANZ XAVER
	<b>Examiner</b> EMMANUEL S. LUK	<b>Art Unit</b> 1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 March 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date 11/14/05.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-31 are pending. Claims 20-31 have been indicated withdrawn by applicants in response to the restriction requirement, however the arguments concerning the restriction have been considered and are persuasive.
  
2. Claims 1-13 and 15, and 20-28 have failed to invoked means plus function pursuant to 35 U.S.C. 112, sixth paragraph. Where means plus function language is used to define the characteristics of a machine or manufacture invention, claim limitations must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof." (Two en banc decisions of the Federal Circuit have made clear that the Office is to interpret means plus function language according to 35 U.S.C. 112, sixth paragraph. In the first, *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the court held:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. In this case, claim 1 did not properly invoke means plus function since the language does not clearly state "means for..." with the stated function, instead it states "...means of a filling device..."

***Specification***

3. Specification should include headings of the different sections as per U.S. practices

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13, 15, and 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have failed to clearly point out and distinctly claim the subject matter, the claims have failed to properly invoke means plus function language and therefore it is unclear as to the subject that is being claimed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1791

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo (2002/0086079) in view of DE900544 (see IDS provided in 10/578,082).

Kuo teaches a lipstick mold with a cavity 11 and elastic mold piece 2 being formed of a resilient or elastic rubber or plastic material that can expand, see [0022], the mold piece (being the same as the mold part) 2 with the cavity 11 are located in a base (being the housing element) 1 having an orifice 12 for the vacuuming device 70 that applies negative pressure within the mold thereby allowing for the elastic mold piece to separate from the cured lipstick material, see [0025], thus ensuring easy removal. As seen with the mold piece, a flange is located in the upper portion, see Figure.

The space around the cavity being the thin fluid layer (as defined by the applicant's specification to be either fluid or gas), in this case an air layer in which the air can be drawn out by the vacuuming device thereby forming a negative pressure and causing the elastic mold piece to separate from the cure lipstick material. In regards to the thickness of the layer, Kuo teaches the cavity surrounding the elastic mold part and this cavity being equivalent to the air layer with a thickness, it would have been obvious to vary the thickness such as the claimed distance as it provides the equivalent function of the peripheral gap of Kuo to facilitate a disengagement of the molded article from the elastic mold part (see page 2 of Kuo, claim 1). As seen in Kuo, the mold part is placed into the housing element and can be used for filling (See Figure 1).

Kuo fails to teach enlarging the housing element to generate a low pressure in the housing space and an actuation element.

DE 900544 teaches an automated lipstick molding apparatus including a device for demolding a shaped mass (page 1, line 6; lipsticks) from a mold 19 with a demolding device 45 and use of pressure for aiding in the ejection (see lines pressure 116), the molds are located upon a rotary device, see Figure 1.

It would have been obvious for one of ordinary skill in the art to modify Kuo with the sliding mechanism and rotary device as taught by DE 900544 for ensuring the molded article is pushed out of the flexible mold by providing a positive ejector mechanism and for producing multiple articles continuously. The arrangement of the orifice on the side of the base can also be rearranged to the plunger portion 45 of DE 900544 for the same result of providing a negative pressure to the flexible mold.

The movement of the actuation element in Kuo in view of DE900544 would allow for the generation of negative pressure. The movement of the actuation element would be akin to a piston in an air chamber wherein the downward movement would expand the air chamber thereby decrease of pressure. (see Hsiao 6010119 as background reference, Col. 2, lines 45-51). It would have been obvious for one of ordinary skill in the art to recognize the movement of the actuation element of Kuo in view of DE900544 to increase the size of the cavity would create the negative pressure that would act upon the flexible mold.

In regards to claims 9 and 24, the shapes of the mold part and housing element are dependent upon the desired shaped article of the user, thus it would have been

Art Unit: 1791

obvious for one of ordinary skill in the art to modify the shapes with cone or other shapes for the lipstick or other molded article.

In regards to the housing element made from metal, in particular of aluminum, the base 1 being made from a metal material would have been obvious for one of ordinary skill in the art since metal is a known material used in machinery, including metal molds (see 3556460 as background reference).

In regards to the mold part made of silicone, the mold part of Kuo is made from elastic rubber or plastic materials and these materials can be substitute for silicone for an equivalent result and since silicone is a known rubber-like polymer.

#### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1791

10. Claims 1, 2, 5-8, 14-15, and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7, 8, 10, 12 of copending Application No. 11/578082.

Copending application teaches same flexible (elastic) mold part, a housing (mold), and sliding mechanism that is capable of pushing the mold out and for providing negative pressure for expanding the flexible mold.

The movement of the sliding mechanism in the copending application would allow for the generation of negative pressure. The movement of the actuation element would be akin to a piston in an air chamber wherein the downward movement would expand the air chamber thereby decrease of pressure. (see Hsiao 6010119 as background reference, Col. 2, lines 45-51). It would have been obvious for one of ordinary skill in the art to recognize the movement of the sliding mechanism to increase the volume of the mold would create a negative pressure to the flexible mold.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Avalle                    2004/0137101

Johnson                2263302

Grisel                 3493309

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMMANUEL S. LUK whose telephone number is (571)272-1134. The examiner can normally be reached on Monday-Fridays from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EL  
/Yogendra N Gupta/  
Supervisory Patent Examiner, Art Unit 1791